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| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER GRAY, JILL M | |
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| | | | 1794 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,174

Applicant(s)

LAWTON ET AL.

Examiner

Jill Gray

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-23 and 27-72 is/are pending in the application.
- 4a) Of the above claim(s) 53-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-23 and 27-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The rejection of claims 1, 3-4, 6-11, 13, 27-30, and 33 under 35 U.S.C. 102(b) as being anticipated by Throne et al., 5,364,657 and 5,370,911 is withdrawn in view of applicants' amendments.

The rejection of claims 1-4, 20-22, 33, and 47-51 under 35 U.S.C. 102(b) as being anticipated by McLarty et al., 3,629,028 is withdrawn in view of applicants' amendments.

The rejection of claims 34-46 under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McLarty et al., 3,629,028 is withdrawn in view of applicants' amendments.

The rejection of claims 6-19 and 52 under 35 U.S.C. 103(a) as being unpatentable over McLarty et al., 3,629,028 is withdrawn in view of applicants' amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-4, 6-23, and 27-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Throne et al., 5,364,657 and 5,370,911 (referred to collectively as Throne).

Throne is as set forth previously and teaches a glass fiber product comprising at least one glass fiber and particles adhered to the at least one glass fiber, said particles having an average dimension within the instant claimed range and being of the type contemplated by applicants. In addition, the glass fiber product can be a prepreg. The particles have an average dimension ranging from 0.1 to 40 microns which is within the claimed range necessary to satisfy the limitation of at least one parameter selected from the particle size and the amount of particles is effective to reduce the tackiness of the glass fiber product, essentially as claimed. Accordingly, the examiner has reason to believe that the glass fiber product of the prior art meets this requirement, in the absence of factual evidence to the contrary. Applicants have provided no such evidence to date. That upon heating the glass fiber is at least partially coated with a coating that is a resin compatible coating. See column 8, lines 12-15. Regarding claims 14-19, as set forth previously, changes in shape are not a matter of invention, in the absence of factual evidence to the contrary unexpected or superior properties of a glass product, wherein said properties are directed related to the specific shape of the particles. Applicants have provided no such evidence. Regarding claims 42-46, since Throne teaches glass fibers coated with particles having a particle size within the claimed range, thereby meeting the required particle size parameter, the examiner has reason to believe that the tractive tension of the resultant fiber product would be within

the instant claimed range as well, in the absence of factual evidence to the contrary. As to claims 47-50, it would have been obvious during routine experimentation to determine the specific proportion of particles for coating the glass fibers.

Response to Arguments

4. Applicant's arguments filed August 5, 2008 have been fully considered but they are not persuasive.

Applicants argue that the examiner has not explained why one would modify the Throne reference so as to contain the claimed coating composition.

In this regard, claim 1 does not set forth any specific requirements of the coating composition. Accordingly, the teaching in Throne of the melted glass fiber coating that is compatible with the matrix material meets the instant requirement of present claim 1.

Applicants' arguments regarding *In re Rose* have been noted. However, it is well settled that changes in shape and size are not construed to be a matter of invention absent a showing to the contrary. Applicants have not clearly identified factual evidence on this record of patentably distinguishable properties of a glass fiber product as claimed, wherein said patentably distinguishable properties are directly related to the specific size and shape of said particles.

No claims are allowed.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jill Gray
Primary Examiner
Art Unit 1794

/Jill Gray/
Primary Examiner, Art Unit 1794